

“new matter” rejection, the “incorporation by reference” paragraph added at line 21 of page 1 (in the Amendment mailed on April 25, 2001) has been canceled and/or deleted without prejudice. It is therefore respectfully requested that the new matter objection be withdrawn.

With respect to paragraph four (4) (as well as any related reasoning in paragraph ten (10)), claims 1 to 7 were rejected under the first paragraph of 35 U.S.C. § 112.

In this regard, to facilitate matters, claim 7 has been rewritten to better define that claim. Accordingly, claim 7 as presented is now directed to a device for activating an electromagnetic consumer having a movable element, the electromagnetic consumer including a solenoid valve for controlling a metering of fuel into an internal combustion engine, the device including: a control arrangement to determine a duration of a time window such that a current flowing through the consumer during the time window does not exceed a threshold value, and to determine a switching instant at which the movable element has reached a particular position within the time window”. It is respectfully submitted that a person having ordinary skill in the art would understand based on the specification, the claims and the drawings that the algorithm of Figure 3 for determining the duration of the time window would be implemented in the control unit 130 (or control arrangement) of Figure 1. It is therefore respectfully submitted that claim 7 is enabled by the present application as it would be understood by a person having ordinary skill in the art.

As regards claim 1 (and its dependent claims 2 to 6) and as further regards claim 7 as presented, it is believed and respectfully submitted that the Final Office Action’s present assertions and arguments at page three (3) reflect the subjective beliefs of the Examiner, and therefore simply do not reflect the proper standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use an invention that is defined by the claims. (See M.P.E.P. § 2164 (even if a claim feature does “lack descriptive support in the disclosure”, this does not mean that the feature is not enabled; a claim feature “in and of itself may enable one skilled in the art to make and use the claim containing” the claim feature).

This standard may not be based on the subjective beliefs of an examiner, but must be based on reasonable arguments that are supported by proper evidence. The Supreme Court established the appropriate standard as requiring the establishment by proper evidence of whether *any experimentation for practicing the invention was undue or unreasonable*. (See

M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is whether “one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art *without undue experimentation*.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has also stated that there are many factors to be considered in determining whether a specification satisfies the enablement requirement. These factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). The Federal Circuit has further stated that it is “*improper* to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that an examiner’s analysis must “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01).

Moreover, to reject the claims as not being enabling, an examiner bears the initial burden of establishing exactly why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.)

In particular, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner’s subjective belief that the specification was not enabling as to the claims. In particular, the examiner’s subjective belief was simply not supported by any

“evidence or sound scientific reasoning” and therefore ignored recent case law -- which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation -- which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence”, and also made clear that “[where an] examiner’s ‘Response to Argument’ is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” (See id. at 1222 & 1223; italics in original). Here, it has not even been conclusorily asserted that undue experimentation would be required.

In view of all of the foregoing, it is believed and respectfully submitted that the Final Office Action’s arguments and assertions do not satisfy the proper evidentiary and judicial standards discussed above. For example, the arguments and assertions presented do not in any way address the established and fundamental law on enablement since they do not relate the scope of the claims to the specification to determine whether the specification is enabling, nor do they properly address the enablement factors. In short, the Office Action’s rejections do not address the proper issue of *whether one having ordinary skill in the art would have to unduly experiment to practice the claimed subject matter of the rejected claims* -- a proposition for which the Office simply has not carried its burden of proving a prima facie case.

In this regard, it is also noted that the Background Information section of the present application states the following:

A method and a device for activating an electromagnetic consumer are known from German Patent No. 44 20 282. That patent describes a device for activating a consumer that includes a movable element. The consumer is a solenoid valve for controlling the metering of fuel into an internal combustion engine. Within a time window, a switching instant at which the

movable element reaches a certain position is detected. This is accomplished by analyzing a time characteristic of a quantity corresponding to the current flowing through the consumer. During the time window when the current is being analyzed, the voltage applied to the consumer is regulated or controlled at a constant value.

In the cold start phase, the leads to the consumer have a low resistance, so the currents reach a higher level at a constant voltage than in normal operation. If current monitoring is provided to switch off the output stage after the current reaches a certain threshold value, this can lead to the output stage being disconnected by the current monitor.

This is problematical in particular when the consumer is connected to the power supply during the time window when the switching instant is detected. The current flowing through the consumer rises to different levels depending on the duration of the time window.

(See Specification, page 1, lines 2 to 20).

Together with the remainder of the disclosure of the present application, the foregoing information concerns, for example, the subject matter of the preamble and the second step of the method of claim 1 -- but not the first step of claim 1 for determining the duration of the time window. It is axiomatic that a person need not describe that which would be understood by a person having ordinary skill in the art.

It is therefore respectfully submitted that the enablement rejections of claims 1 to 7 should be withdrawn based on all of the foregoing.

With respect to paragraph six (6), claims 1 to 7 were rejected as indefinite under the second paragraph of 35 U.S.C. § 112.

As to claim 1, the indefiniteness rejection is simply not understood since the Final Office Action has not specifically stated why this claim is indefinite, except to ambiguously assert that the "construction of the method claims renders them indefinite". It is respectfully submitted that claim 1 is definite at least because a person having ordinary skill in the art would understand that claim does particularly point out and distinctly claim the patentable subject matter.

As regards claims 2 to 5 as presented, it is respectfully submitted that they are plainly definite in view of the rewriting of those claims, and in view of the fact that claim 1 is

definite.

As regards claim 6, it is definite for the same reasons as claim 1 from which it depends.

As regards claim 7, the indefiniteness rejection is simply not understood since the Final Office Action offered no explanation whatsoever as to why claim 7 was rejected as indefinite. In any event, it is respectfully submitted that claim 7 as presented is definite at least because a person having ordinary skill in the art would understand that claim does particularly point out and distinctly claim the patentable subject matter.

It is therefore respectfully submitted that the indefiniteness rejections of claims 1 to 7 should be withdrawn.

With respect to paragraph six (6), claims 1 to 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over Heinzelmann et al., U.S. Patent No. 6,097,585.

The Heinzelmann reference is only a reference under 35 U.S.C. § 102(e). In this regard, Applicants state that the subject matter of the Heinzelmann reference and the claimed invention of the present application “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person”, with Robert Bosch GmbH being the “same person”. It is therefore respectfully submitted that the reference must be removed under 35 U.S.C. § 103(c) in view of the foregoing statement, and it is respectfully requested that the obviousness rejections be withdrawn. (See 1241 O.G. 96 (December 26, 2000) concerning revised guidelines for removing a reference under 35 U.S.C. § 103(c), which provides for the attorney of the Applicants to make the “commonly owned” statement).

It is therefore respectfully requested that the obviousness rejections of claims 1 to 7 be withdrawn, and it is submitted that claims 1 to 7 are allowable.

In summary, it is respectfully submitted that claims 1 to 7 are allowable for the foregoing reasons.

### **CONCLUSION**

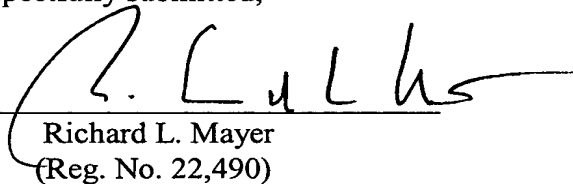
In view of all of the above, it is believed that the objections to and the rejections of the claims have been obviated, and that claims 1 to 7 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

Dated: \_\_\_\_\_

9/28/01

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**AMENDMENT VERSION WITH MARKINGS**

**IN THE CLAIMS:**

Please amend without prejudice the claims as follows:

2. (Twice Amended) The method according to claim 1, [further comprising the step of] wherein the step of determining the duration includes increasing the duration of the time window if the current is lower than the threshold value.
3. (Amended) The method according to claim 1, [further comprising the step of] wherein the step of determining the duration includes reducing the duration of the time window if the current is greater than the threshold value.
4. (Twice Amended) The method according to claim 1, [further comprising the step of] wherein the step of determining the duration includes increasing the duration of the time window until a maximum value for the duration is reached.
5. (Amended) The method according to claim 1, [further comprising the steps of:] wherein:  
the consumer is arranged to receive [receiving] a power supply voltage at the consumer during a period of time; and  
the step of determining the switching instant includes analyzing a time variation of the current to determine the switching instant.
7. (Amended) A device for activating an electromagnetic consumer having a movable element, the electromagnetic consumer including a solenoid valve for controlling a metering of fuel into an internal combustion engine, the device comprising:  
[means for] a control arrangement to determine[ing] a duration of a time window such that a current flowing through the consumer during the time window does not exceed a threshold value, and [; and  
means for] to determine[ing] a switching instant at which the movable element has reached a particular position within the time window.